

REMARKS

Claims 39 and 40 are the only claims at issue. The Examiner rejected claims 39 and 40 under 35 U.S.C. § 112 as failing to comply with the written description requirement. The basis for this rejection is found on pages 2 and 3 of the Office Action mailed 11/30/2005, where the Examiner stated that

“...claim 39 contains the limitation ‘a particulate layer...is at least two particulate particles thick.’ The specification does not disclose the thickness of the particulate layer, therefore this limitation is considered new matter.” “Furthermore, the drawings do not support this limitation since figure 9 shows that the particle layer is discontinuous and sometimes not even one particle thick.”

Applicant presents below the relevant portion of the informal drawing of Fig. 9 that was submitted with the application of which the present application is a divisional. Applicant has also enclosed a replacement Fig. 9 that more accurately shows the details of the informal drawing. The informal drawing and appended replacement drawing sheet clearly show the existence of numerous particles through the thickness of the flooring unit, and the particulate layer is at least two such particles thick. There are at least two particles shown between the top of the flooring unit and the fiber layer. Thus, the claim limitation that the particulate layer is at least two particles thick is fully supported by the specification.

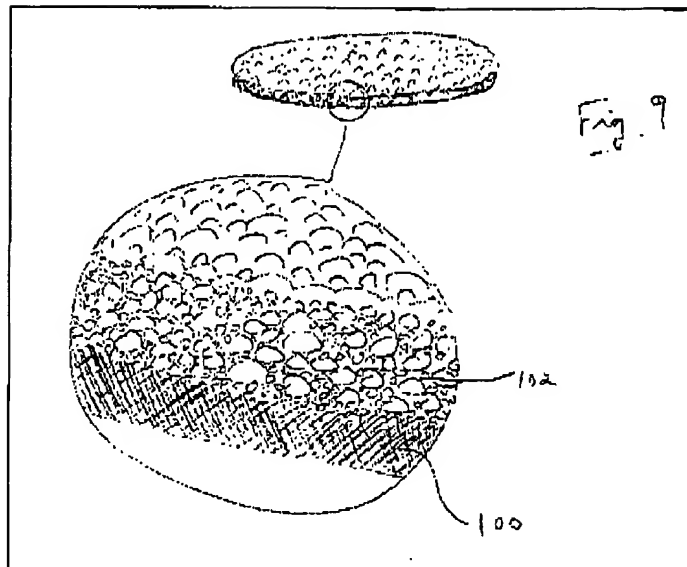
The legal standard for determining whether the written description requirement has been met is whether the specification “convey[s] with reasonable clarity to those

skilled in the art that, as of the filing date sought, he or she was in possession of *the invention*.”¹ The *Alton* Court pointed out that:

“In order to meet the adequate written description requirement, the applicant does not have to utilize any particular form of disclosure to describe the subject matter claimed, but ‘the description must clearly allow persons of ordinary skill in the art to recognize that [he or she] invented what is claimed’” *In re Alton*, 37 USPQ 2d 1578, 1581.

The informal Fig. 9 shows the flooring unit with a clear view of the side and the particles across the unit’s thickness. The specification at paragraph [0038] also describes Fig. 9 as showing “[a] finished molded unit” after “epoxy resin, is mixed with stones and the mixture is poured into the mold over the fibers.” “The top, wearing surface of the molded unit is formed by the stones coated with epoxy resin 102...”. These resin-coated stones 102 are shown from the side view of Fig. 9, and constitute the particulate of the unit, as the term “particulate” is defined in paragraph [0020]. The stones are of various sizes in Fig. 9, and the thickness of the particulate layer is at least two such stones thick. Thus, Fig. 9 and the description clearly allow persons of ordinary skill in the art to recognize that the inventor invented what is recited in claim 39.

¹ *In re Alton*, 37 USPQ 2d 1578, 1581 (Fed. Cir. 1996) (emphasis in original).



BEST AVAILABLE COPY

The Federal Circuit has stated that drawings can provide a written description of an invention. *Vas-Cath, Inc. v. Mahurkar*, 935 F.2d 1555 at 1565, 19 USPQ 2d 1111 (Fed. Cir. 1991) ("under proper circumstances, drawings alone may provide a 'written description' of an invention as required by § 112."). In this case, there is a drawing and a description referring to the drawing and discussing the parts thereof. Therefore, Applicant respectfully requests that the rejection be withdrawn, because the written description requirement has been met.

In the drawing the change is an increased number of particles shown in the side of the flooring unit as in the informal Fig. 9.

In the Advisory Action mailed 3/16/2006, at pages 2-3, the Examiner stated,

"Figure 9 does not differentiate, e.g., point out, which parts of the drawing refer to stones or fibers. Therefore, it is impossible for the examiner to distinguish whether the drawing is showing fibers or stones in the matrix, since Applicant has not identified either in any of the drawings.... When the specification does not disclose that the drawings are to scale and is silent as to dimensions, arguments based on measurement of the drawing features are of little value. M.P.E.P. 2125."

First, Fig. 9 does differentiate which parts of the drawing refers to stones and which part refers to fibers. In the specification at page 13, lines 16-18, the fibers are given the reference numeral 100 ("fibers 100 are placed in the mold. A finished molded unit is shown in Fig. 9"). Fig. 9 shows reference numeral 100 pointing to a layer of intersecting lines, which is the appearance that woven or randomly oriented glass or other reinforcing fibers have when they are in a composite. The specification also discusses "stones coated with epoxy resin 102" at page 14, lines 1-2. Fig. 9 shows reference numeral 102 pointing to a small particle, which clearly represents a stone coated with epoxy resin that forms the matrix. Thus it is possible to distinguish the stones from the fibers, and one can see that the illustration of Fig. 9 shows the thickness of the structure being greater than two of such stones.

Second, the Examiner's citation of M.P.E.P. 2125 is not relevant to the issue at hand: whether the specification "convey[s] with reasonable clarity to those skilled in the art that, as of the filing date sought, he or she was in possession of the invention." M.P.E.P. 2125 relates to whether patent drawings can anticipate claims, not whether they can support the argument of what the specification reasonably conveys to those skilled in the art. This M.P.E.P. section states that "the description of the article pictured can be relied on, in combination with the drawings, for what they would reasonably teach one of ordinary skill in the art." The drawing and specification reasonably teach one of ordinary skill that Applicant's flooring unit has a particulate layer that is at least two particles thick.

Furthermore, Applicant is not making an argument based on measurement of a drawing, as the Examiner pointed out and the M.P.E.P. section discusses. Instead, Applicant is making an argument based on the number of particles that the drawing discloses through the flooring unit's thickness. This specific number of clearly identified stones conveys that Applicant was in possession of the invention. Now that the standard has been met, Applicant deserves a comparison of the invention to the prior art.

Nevertheless, Applicant herein adds a claim to the range of thicknesses of the particulate coating, as disclosed on page 11, lines 5-6 of the specification.

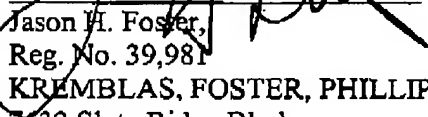
Therefore, reconsideration and allowance are respectfully requested.

The examiner is authorized to communicate with the undersigned attorney by email by the following recommended authorization language: Recognizing that Internet communications are not secure, I hereby authorize the USPTO to communicate with me concerning any subject matter of this application by electronic mail. I understand that a copy of these communications will be made of record in the application file. (authorization pursuant to MPEP 502.03)

The Commissioner is authorized to charge Deposit Account No. 13-3393 for any insufficient fees under 37 CFR §§ 1.16 or 1.17, or credit any overpayment of fees.

Respectfully submitted,

01 May 2006
Date of Signature


Jason H. Foster,
Reg. No. 39,981
KREMBLAS, FOSTER, PHILLIPS & POLLOCK
7632 Slate Ridge Blvd.
Reynoldsburg, OH 43068
Voice: 614/575-2100
Fax: 614/575-2149
email: jfoster@ohiopatent.com

Enclosures: Petition for Extension of Time
Request for Continued Examination Transmittal
Credit Card Payment Form